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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,450

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Eiji Kubota

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04/06/2009

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EXAMINER

DULANEY, BENJAMIN O

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,450

Applicant(s)

KUBOTA, EIJI

Examiner

BENJAMIN O. DULANEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 12/5/08, with respect to claims 5 and 6 have been fully considered and are persuasive. The 35 U.S.C. 112, second paragraph rejection of claims 5 and 6 has been withdrawn.

Applicant's arguments, filed 12/5/08, with respect to claim 14 have been fully considered and are persuasive. The 35 U.S.C. 101 rejection of claim 14 has been withdrawn.

Applicant's arguments filed 12/5/08 have been fully considered but they are not persuasive.

Regarding applicant's argument for claim 1 that Hagstrom does not teach printing a base line at a "precise position", examiner disagrees. For a position to be precise it merely needs to be definitely or strictly stated, defined, or fixed. Since Hagstrom specifically states that base line markings "are spaced a known, selected distance apart" the markings are certainly precise in relation to each other (column 4, lines 20-21). Therefore positions of baseline markings in Hagstrom are "precise" and the disputed feature is taught.

Note: a new rejection is formulated for claims 4 and 6 in view of the fact that the "wherein" language of the claims that suggests or makes optional but does not require steps to be performed or does not limit the claims to a particular structure, does not limit

the scope of claims 4 and 6 (see MPEP 2106). If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore a new rejection is formulated in view of U.S. patent 5,337,668 by Matsuoka et al.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 3) Claims 1-3, 5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,927,208 by Hagstrom et al.
- 4) Regarding claims 1, 10, 13 and 14, Hagstrom teaches a print controller for determining an amount of misalignment of print position on directly printing on a label surface of an electronic information recording medium, said print controller comprising: a marker print unit (figure 2, item 57; column 3, lines 54-56; program controls the printer) for controlling a printing apparatus to print a marker at a predetermined position of an adjustment medium on which a base line is previously printed at a precise position to determine said amount of misalignment and which has a shape identical to said electronic information recording medium (column 4, lines 13-67); an input unit for inputting from a user at least two pieces of portion specifying information for specifying portions where said base line and said marker have a predetermined positional relationship (column 5, line 18); and a misalignment amount determination unit (column

5, line 18; control computer 115 is the determination unit) for determining said amount of misalignment based on the positional relationship between an absolute position at which said base line should be located and the portions specified by said portion specifying information (column 5, lines 19-29).

5) Regarding claim 2, Hagstrom teaches a print controller according to claim 1, wherein one of said base line and said marker includes a circle (figure 4), and the other includes scale marks printed at predetermined intervals on at least two axes that are directed from the center of said adjustment medium to the circumference of said circle and differ in direction (figure 4).

6) Regarding claim 3, Hagstrom teaches a print controller according to claim 2, wherein said axes include two axes directed from the center of said adjustment medium to a x-direction and a y-direction that are reference directions for determining said amount of misalignment (figure 4, item 79 and 86).

7) Regarding claim 5, Hagstrom teaches a print controller according to claim 2, wherein when the direction of said determined amount of misalignment is not identical to said x-direction or said y-direction that is a reference direction for determining said amount of misalignment, said misalignment amount determination unit resolves said amount of misalignment into its x-component and y-component to determine said x-component and said y-component (figure 4; column 5, lines 15-17 and 21-29).

8) Regarding claim 7, Hagstrom teaches a print controller according to claim 1, wherein said input unit inputs portion specifying information related to portions at which said base line overlaps with said marker (column 5, line 18).

- 9) Regarding claim 8, Hagstrom teaches a print controller according to claim 1, said print controller further comprising: a print data generation unit for generating print data that reflects the amount of misalignment determined by said misalignment amount determination unit and is then output to said printing apparatus (column 4, lines 13-67).
- 10) Regarding claims 9 and 12, Hagstrom teaches A printing apparatus, said printing apparatus comprising: a misalignment amount input unit for inputting an amount of misalignment determined by said print controller according to claim 1; a print data input unit for inputting print data to be printed; and a print unit for correcting a print position of said print data based on said amount of misalignment and then printing (Column 3, lines 54-58).
- 11) Regarding claim 11, Hagstrom teaches a print controller according to claim 10, wherein at least one of said base line and said marker is provided with scale marks for specifying said positional relationship, and said positional relationship specifying information is specified based on said scale marks (figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,927,208 by Hagstrom et al. as applied to claim 1 above, and further in view of U.S. patent 5,337,668 by Matsuoka et al.

13) Regarding claim 4, Hagstrom does not specifically teach a print controller according to claim 3, wherein scale marks on an axis directed to a direction other than said reference direction differ in distance from the center of said adjustment medium by a predetermined amount relative to the scale marks on said axes directed to said x-direction and said y-direction.

Matsuoka teaches a print controller according to claim 3, wherein scale marks on an axis directed to a direction other than said reference direction differ in distance from the center of said adjustment medium by a predetermined amount relative to the scale marks on said axes directed to said x-direction and said y-direction (column 4, lines 43-63; Matsuoka can print vectors of varying angles which would met the intended use limitation of a third axis with scale marks).

Hagstrom and Matsuoka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hagstrom and Matsuoka to add a third axis with scale marks. The motivation for doing so would have been to produce a "register mark pattern" (column 1, line 42). Therefore it would have been obvious to combine Hagstrom with Matsuoka to obtain the invention of claim 4.

Note: To overcome the intended use rejection examiner suggests tying the wherein clause to a particular structure, such as claiming "wherein ***the marker print unit prints*** scale marks ...", or the like.

14) Regarding claim 6, Hagstrom does not specifically teach a print controller according to claim 1, wherein one of said base line and said marker includes two straight lines in said x-direction and in said y-direction that are reference directions for determining said amount of misalignment, and the other includes scale marks arranged at predetermined intervals on a line that intersects with each of said straight lines at a predetermined angle.

Matsuoka teaches a print controller according to claim 1, wherein one of said base line and said marker includes two straight lines in said x-direction and in said y-direction that are reference directions for determining said amount of misalignment, and the other includes scale marks arranged at predetermined intervals on a line that intersects with each of said straight lines at a predetermined angle (column 4, lines 43-63; Matsuoka can print vectors of varying angles which would met the intended use limitation of a third axis with scale marks).

Hagstrom and Matsuoka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hagstrom and Matsuoka to add a third axis with scale marks. The motivation for doing so would have been to produce a "register mark

pattern" (column 1, line 42). Therefore it would have been obvious to combine Hagstrom with Matsuoka to obtain the invention of claim 6.

Note: To overcome the intended use rejection examiner suggests tying the wherein clause to a particular structure, such as claiming "wherein ***the marker print unit prints*** one of said base line and said marker ***to include*** two straight lines ...", or the like.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625